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Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/787,205
Filing Date: February 27, 2004
Appellant(s): WECHSEL

_____
Jack R. Smith
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 08/30/11 appealing from the Office action

mailed 03/01/11.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest is contained in the brief

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The copy of the appeal claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence relied upon in the rejection of claims

under appeal;

HAUSER ET AL, US 6,536,659, filed on Nov. 15, 2000, and issued date Mar. 25,

2003.

BLOOM, Patent Application Publication US 2002/0178074, filed on May. 24,

2001.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

    1.   Determining the scope and contents of the prior art.
    2.   Ascertaining the differences between the prior art and the claims at issue.
    3.   Resolving the level of ordinary skill in the pertinent art.

     4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

3.   Claims **1-6, 9-36, 40-47** are rejected under 35 U.S.C. 103(a) as being unpatentable over HAUSER ET AL (US 6,536,659) in view of BLOOM (US 2002/0178074).

     As for independent claim 1, HAUSER ET AL discloses a computer implemented method for managing a return of a product, the method comprising:

     1) receiving at a first computer management system (a merchant computer) a return request for the product

     {see at least figures 1, 4-6, col. 3, lines 45-48, col. 8, lines 10-22 discloses the merchant (14) or merchant web site 212 receive a request from customer for returning merchandise},

     wherein the return request is for a quantity of the product great than one {see col. 4, lines 9-15, discloses a description of the merchandise that identifies items/quantity that should be included for the return request from customer}

     2) determining whether the return request is authorized;

     {see at least figures. 1, 4-6, col. 3, lines 56-63, col. 4, lines 1-15, col. 8, lines 23-44, and lines 59-67, col. 9, lines 1-3, discloses the merchant (14) or return authorization engine 216 of merchant determine *the authorization for the return of the merchandise*};

     3) creating a first record in the first system in response to a determination that the return request is authorized, the first record including a return authorization number (RAN)

{see at least col. 8, lines 1-54 discloses the merchant create the return

authorization barcode record and send it to the customer e.g. *when customer contact a*

merchant website for return product for requesting authorization to return merchandises

previously purchased, if the reason for making a return is satisfies, the return

authorization engine will automatically send return authorization bar code and prepaid

shipping label to the customer by email or a printable attachment to an email.

4) issuing (providing/sending), from a first computer implement system of a

supplier, a return authorization information including authorization number (RAN) or bar

code for the return request when the return request is determined to be authorized;

{see at least figures 4-6B, col. 7, lines 63-67, col. 8, lines 1-10 disclose a

authorization bar code/RAN is *provided*/issued *to customer from a merchant 202/*a first

management system; and col. 8, lines 30-60 merchant (14) or return authorization

engine (213) as a first system that *send or provide* or *distribute the authorization bar*

code/or RAN to the customer}

5) creating a second record in a second computer implemented system in

response to receiving the RAN from the first system, the second record being a

warehouse request comprising a pending delivery item which including the RAN, a

product type, and the quantity of the product associated with the return request;

{see at least col. 4, lines 9-15, discloses the merchant (first system) who has

authorized the return of merchandise transmit the return data to the central return

service/return online Inc/warehouse (2nd system); and col. 4, lines 49-67; col. 5, lines 1-

19 discloses *the return merchandise is received at the return Online Inc, scans the*

return authorization label applied to the shipping container of merchandise that has

been received. Based upon merchant identified by the bar code on the shipping label,

the container conveying the merchandise is sorted and transferred to an appropriate

processor station. At the processor station, the contents of a shipping container are

inspected and the processor verifies that the contents receives in the container match

the expected contents, based upon data received from the merchant who authorized the

return shipment; and

See also col.6, lines 18-49 discloses National Return Center or Central return

facility 100 or Online Return Inc as a second computer management system wherein

the record or information/data e.g. a *return authorization label including an authorization*

bar code/RAN is stored in the database on computer 56}. As for the information about

the pending delivery item include product type and quantity of the return product, this is

inherently included in HAUSER ET AL since HAUSER discloses the second system

verifies or determines whether the received return product is matched with the return

product record that is received from the first system (merchant).

6) searching a database of the second system for the pending delivery item using

a RAN associated with a product received at a warehouse;

{see at least see col.6, lines 18-49; col. 6, lines 18-49 discloses verified against

the expected contents/product as indicated in the data stored in the database. And also

col. 4, lines 49-64 discloses the processor verifies that the contents/product received in

the container match the expected contents/product, based up on the data received from

the merchant, the contents product is in association with the authorization code that

identifying the merchant and the merchandise being returned}. This is inherently

determine the searching database for the product return in order to verify or match the

received product with the returned product associated with the authorization code

stored in the database.

 7) determining, based on searching the database, if the quantity of the product

associated with the return request included in the second record matches a quantity of

the product received at the ware house

 See col. 4, lines 58-64 discloses *At the processor station, the contents of a*

shipping container are inspected and the processor verifies that the contents receives in

the container match the expected contents, based upon data received from the

merchant who authorized the return shipment; and col. 6, lines 46-49 discloses the

contents/product are verifying against the expected product as indicated in the data

stored in the database.

 10) updating the second record (entering new data about the return product) to

reflect that the quantity of the product associated with the return request included in the

second record matches the quantity of the product received at the warehouse.

 {see figure 2, col. 2, lines 27-37; col. 5, lines 5-19 disclose information/data about

the product return is entered into the central database of Central return facility to

indicate that the merchandise has been received; and if the return product that was

received match the expected merchandise, an electronic transmission/message is sent

to merchant 14 indicating a complete return of the merchandise occurred}

Note, as for the term "first computer implemented management system" and "second computer implement management system", this is inherently included in the "merchant customer product return system" and "central return facility network system" {see Figs. 1-2}. Furthermore, the claim limitation doesn't exclude a first computer implemented management system and a second computer implemented management system from being different system. While the claim recites that these systems are the systems of the supplier, the ownership of the system doesn't appear to make a manipulative different in a method step of "creating a record'. Therefore, Hauser discloses "creating a record in the Central return facility comprising a database" which corresponds to the claimed limitation "creating a record in a second computer system of the supplier".

Also as indicated above, the limitation "updating a record" in the last step, this is inherently included in the features "*product return is entered into the central database to indicate that the merchandise has been received*, and *send the message to the merchant indicating a complete return of the merchandise occurred* {see figure 2, col. 2, lines 27-31; col. 5, lines 5-19}.

HAUSER ET AL discloses the claimed invention as indicated above. HAUSER ET AL further discloses the quantity or number of items to be returned from the customer, and this information/record is stored in the database system {col. 4, lines 2-23, col. 6, lines 18-49, col. 7, lines 19-37}. However, HAUSER ET AL doesn't mention the conditions of "splitting/dividing the record into a plurality of new records/files including the RAN and having different statuses, wherein the different statuses indicate

return of a quantity of the product, when the quantity of the product associated with the

return request included in the second record does not match the quantity of the product

received at the warehouse"; and the condition of "re-combining the plurality of new

records into the second record when the quantity of the product associated with return

request included in the second record matches the quantity of the product received at

the warehouse"; (steps 8 and 9).

However, It is noted the splitting/dividing the records is considered as the

conditional/optional language based on <u>when</u> the quantity of the product in the record

does not match the quantity of the product received at the warehouse, then the splitting

record will occur. In the other words, if all of the quantity/or full of the quantity is

received at the same time, then the splitting/dividing record in to a Plurality of new

records files will not occur or happen.   This is similar to the step of "recombining" the

plurality or records into a single record <u>when </u>all the quantity received product matches

with the quantity of product in the second records.   In the other words, if the quantity of

product included in the second record doesn't match with the quantity of product

received at the warehouse, then the action of re-combining all the records into the

single record will not happen.

According to the MPEP, "language that suggests or makes optional but does not

require steps to be performed or does not limit a claim to a particular structure does not

limit the scope of a claim or claim limitation" (MPEP 2106.II. C).

Furthermore, **BLOOM** in par. 0099, figure 9A-9B discloses the well known

feature of the splitting record of order in to different records or files in order to make

adjustments for an Order Detail record 1202 to partially fill an order, where a select

order an Order Detail record 1202 has a SKU/identifier number quantity greater than

what can be filled. The program (312) creates a new Order Detail Record 1202 and

splitting the Order Detail Quantity across the new record 1202 and the existing record

1202. The program (312) creates a new Order Detail record 1202 by copying all the

values of the existing record 1202, except for quantity.   *Status can be updated to either*

a value such as "retailer shipment-new" or "retailer shipment –back order" on the new

Order Detail record 1202 depending upon the status of the existing record 1202.

Quantity of the existing record can be reduced by the quantity of the new record Status

and Retailer shipment ID (status) on the existing record 1202 are not changed when the

record 1202 is split. (This implies that only the status of existing record 1202 is not

change, which means that the status of new record 1202 can be changed). For

example BLOOM par. 0187, lines 30-79 indicates if the quantity of physical product is

less than the quantity of product in the data records, "*a new Order Detail record 1202*

can be created to split the quantity on the existing record 1202, resulting in the existing

record 1202 retaining its Package ID and Status and having an adjusted Quantity to

match the actual physical quantity that was in the package and the new record 1202

having the same Order ID, a quantity equal to short adjustment quantity, a *Status value*

such as "destination RDC" which indicates the package ID should be repacked.

Therefore, It would have been obvious to one of ordinary skill in the art at the

time of the invention to modify the created record of HAUSER ET AL by splitting the

record order into different record as taught by BLOOM so that the adjusted quantity

product in a new record <u>would match</u> with the actual physical quantity of product that

was received/or received quantity of product and also would be easy to keep track of

what item/product have been received {see Bloom, par. 0187, lines 43-79}.

HAUSER/BLOOM teaches the claimed invention as indicated above. However,

HAUSER/BLOOM does not mention about the recombining the records into the single

record when the quantity of the product in the record matches the quantity of the

received product.

Since HAUSER/BLOOM teaches discloses the splitting the record into another

records when the problem occur such as when the quantity of received product does

not match with the original quantity of product stored in the record as stated as above.

Therefore, it would have been obvious to one of ordinary skill in the art to recombine the

all the records into a single record when the quantity of received product matches with

the original quantity of product stored in the record in order to indicate the problem has

been solved as well as saving the space in the data storage.

Also, as for the limitation splitting the second record into a plurality of new

records including the RAN and having different statues, wherein the different statuses

indicate return of a quantity of the product ". Noted that the type of statuses

data/information indicate return of a quantity of the product is considered as non-

functional descriptive material because it does not explicitly alter or impact the

step/function of "splitting the record into a plurality of new records" and only means

something to the human mind, thus given little patentable weight. In the other words,

regardless what type of information contain in the records, the step/function "splitting the

record into a plurality of new records" will not change or impact and the information/data

indicate return of a quantity of the product does not patentably distinguish the claimed

invention form the prior art in terms of patentability. See King Pharmaceuticals Inc. v.

Eon Labs Inc., 95 USPQ2d 1833 (Fed. Cir. 2010).

     As for dep. claim 2, which deals with the first management system is a

customer relationship management system (CRM), this is taught in HAUSER ET AL,

see at least figures 1, 4-6B disclose a merchant (14), merchant (202), or merchant

website (212), and merchant call center 214 where the customer can directly contact.

     As for dep. claim 3, which deals with the second management system

comprises a ware house management (WM) system, this is taught in HAUSER ET AL,

figures 2-3 "return central facility".

     As for dep. claim 4, which deals with the information/data/or record about the

delivery request, this is taught in HAUSER ET AL, col. 2, lines 27-38.   Note: "the

record/information or data of a delivery request" have been determined to be non-

functional descriptive material (NFDM), thus having no patentable weight and does not

need to be taught by the prior art. Nonfunctional descriptive material cannot render

nonobvious an invention that would have otherwise been obvious. In re Gulack,703 F.

2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not

functionally related to the substrate, the descriptive material will not distinguish the

invention from the prior art in terms of patentability. See MPEP 2106.01.

As for dep. clam **5**, which deals with the communicating information between the two parties, e.g. first and second management system utilizing the RAN, this is taught in HAUSER ET AL, col. 2, line 5-23, 21-57,figure 1-2.

As for dep. claim **6**, which deals with providing a shipping label in response to approving the return request, the shipping label comprising the RAN, this is taught in HAUSER ET AL, figures 1-2, col. 4, lines 15-22.

As for **independent claim 9**, HAUSER ET AL discloses a computer implemented method for managing a return of a product, the method comprising:

1) authorizing, using a first computer-implemented management system a request from a customer to return a product

{see at least figures. 1, 4-6, col. 3, lines 56-63, col. 4, lines 1-15, col. 8, lines 23-44, and lines 59-67, col. 9, lines 1-3, discloses the merchant (14) or return authorization engine 216 of merchant determine *the authorization for the return of the merchandise*}

wherein the return request is for a quantity of the product great than one {see col. 4, lines 9-15, discloses a description of the merchandise that identifies items/quantity that should be included for the return request from customer}

2) creating at least one record in a second computer implemented system when the request for the product return is authorized, the at least one record being a warehouse request comprising a pending delivery item, the pending delivery item including a unique identifier, a product type, and the quantity of the product associated with the request;

{see at least col. 4, lines 9-15, discloses the merchant (first system) who has authorized the return of merchandise transmit the return data to the central return service/return online Inc/warehouse (2nd system); and col. 4, lines 49-67; col. 5, lines 1-19 discloses *the return merchandise is received at the return Online Inc, scans the return authorization label applied to the shipping container of merchandise that has been received. Based upon merchant identified by the bar code on the shipping label, the container conveying the merchandise is sorted and transferred to an appropriate processor station. At the processor station, the contents of a shipping container are inspected and the processor verifies that the contents receives in the container match the expected contents, based upon data received from the merchant who authorized the return shipment*; and

See also col.6, lines 18-49 discloses National Return Center or Central return facility 100 or Online Return Inc as a second computer management system wherein the record or information/data e.g. a *return authorization label including an authorization bar code/RAN is stored in the database on computer 56*}. As for the information about the pending delivery item include product type and quantity of the return product, this is inherently included in HAUSER ET AL since HAUSER discloses the second system verifies or determines whether the received return product is matched with the return product record that is received from the first system (merchant).

3) assigning the unique identifier to the product return;

{see at least figures 4-6B, col. 7, lines 63-67, col. 8, lines 1-10 disclose a authorization bar code/RAN is *provided*/issued *to customer from a merchant 202*/a first

management system; and col. 8, lines 30-60 merchant (14) or return authorization

engine (213) as a first system that *send or provide* or *distribute the authorization bar*

code/or RAN to the customer}

     4) associating the unique identifier with each record corresponding the product to

be returned/received;

     {see figures 1-2, 5-6B, col. 4, lines 16-56, col. 5, lines 5-20, col. 6, lines 18-49

disclose the transmitting the authorization bar code/unique identifier about the return

product from the merchant system to the return facility system, the facility issues the

return label including the bar code/unique identifier to customer, when the

merchandise/product is returned at the facility, the bar code will be scanned to identify

the merchant and merchandise being returned}

     5) searching a database associated with the second systems for the pending

delivery item using a unique identifier associated with a product received at a

warehouse;

     {see at least see col.6, lines 18-49; col. 6, lines 18-49 discloses verified against

the expected contents/product as indicated in the data stored in the database. And also

col. 4, lines 49-64 discloses the processor verifies that the contents/product received in

the container match the expected contents/product, based up on the data received from

the merchant, the contents product is in association with the authorization code that

identifying the merchant and the merchandise being returned}. This is inherently

determine the searching database for the product return in order to verify or match the

received product with the returned product associated with the authorization code
stored in the database.

6) determining, based on searching the database, if the quantity of the product
associated with the return request included at least one record matches a quantity of
the product received at the warehouse;

See col. 4, lines 58-64 discloses *At the processor station, the contents of a
shipping container are inspected and the processor verifies that the contents receives in
the container match the expected contents, based upon data received from the
merchant who authorized the return shipment*; and col. 6, lines 46-49 discloses the
contents/product are verifying against the expected product as indicated in the data
stored in the database.

7) Exchanging/transmitting information regarding the product return between the
pluralities of computer management systems utilizing the unique identifier;

{see at least figures1, 5-6B, col. 2, lines 9-25, lines 49-59; col. 5, lines 5-19 col.
8, lines 29-54 disclose the transmitting of the RA data (218) about the product return
from the merchant system (return authorization engine) to the national return center
system. This indicates that the unique identifier is stored in both systems (merchant
and central return facility). The facility issues the return label including the bar
code/unique identifier to customer, when the merchandise/product is returned at the
facility; the bar code will be scanned to identify the merchant and merchandise being
returned. If the return product that was received/returned match the expected

merchandise, an electronic transmission/message is sent to merchant 14 indicating a

complete return of the merchandise occurred}.

Note, as for the term "management" in the "computer implement systems" this is

inherently included in the "merchant customer product return system" and "central

return facility network system" {see Figs. 1-2}.

HAUSER ET AL discloses the claimed invention as indicated above. HAUSER

ET AL further discloses the quantity or number of items to be returned from the

customer, and this information/record is stored in the database system {col. 4, lines 2-

23, col. 6, lines 18-49, col. 7, lines 19-37}. However, HAUSER ET AL doesn't mention

the conditions of "splitting/dividing the at least one record in each of the second systems

into a plurality of new records including the unique identifier and having different

statuses, when the quantity of the product associated with the request included in the at

least one record does not match the quantity of the product received at the warehouse".

However, It is noted the splitting/dividing the records is considered as the

conditional/optional language based on <u>when</u> the quantity of the product in the record

does not match the quantity of the product received at the warehouse, then the splitting

record will occur. In the other words, if all of the quantity/or full of the quantity is

received at the same time, then the splitting/dividing record in to a Plurality of new

records files will not occur or happen.

According to the MPEP, "language that suggests or makes optional but does not

require steps to be performed or does not limit a claim to a particular structure does not

limit the scope of a claim or claim limitation" (MPEP 2106.II. C).

Furthermore, **BLOOM** in par. 0099, figure 9A-9B discloses the well-known

feature of the splitting record of order in to different records or files in order to make

adjustments for an Order Detail record 1202 to partially fill an order, where a select

order an Order Detail record 1202 has a SKU/identifier number quantity greater than

what can be filled. The program (312) creates a new Order Detail Record 1202 and

splitting the Order Detail Quantity across the new record 1202 and the existing record

1202. The program (312) creates a new Order Detail record 1202 by copying all the

values of the existing record 1202, except for quantity.   *Status can be updated to either*

a value such as "retailer shipment-new" or "retailer shipment –back order" on the new

Order Detail record 1202 depending upon the status of the existing record 1202.

Quantity of the existing record can be reduced by the quantity of the new record Status

and Retailer shipment ID (status) on the existing record 1202 are not changed when the

record 1202 is split. (This implies that only the status of existing record 1202 is not

change, which means that the status of new record 1202 can be changed). For

example BLOOM par. 0187, lines 30-79 indicates if the quantity of physical product is

less than the quantity of product in the data records, "*a new Order Detail record 1202*

can be created to split the quantity on the existing record 1202, resulting in the existing

record 1202 retaining its Package ID and Status and having an adjusted Quantity to

match the actual physical quantity that was in the package and the new record 1202

having the same Order ID, a quantity equal to short adjustment quantity, a *Status value*

such as "destination RDC" which indicates the package ID should be repacked.

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the created record of HAUSER ET AL by splitting the record order into different record as taught by BLOOM so that the adjusted quantity product in a new record would match with the actual physical quantity of product that was received/or received quantity of product and also would be easy to keep track of what item/product have been received {see Bloom, par. 0187, lines 43-79}.

Also, as for the limitation splitting the second record into a plurality of new records including the RAN and having different statues, wherein the different statuses indicate return of a quantity of the product ". Noted that the type of statuses data/information indicate return of a quantity of the product is considered as nonfunctional descriptive material because it does not explicitly alter or impact the step/function of "splitting the record into a plurality of new records" and only means something to the human mind, thus given little patentable weight. In the other words, regardless what type of information contain in the records, the step/function "splitting the record into a plurality of new records" will not change or impact and the information/data indicate return of a quantity of the product does not patentably distinguish the claimed invention form the prior art in terms of patentability.

See King Pharmaceuticals Inc. v. Eon Labs Inc., 95 USPQ2d 1833 (Fed. Cir. 2010) as applied to the method claims 1, 9, 13, and 20; and also See MPEP 2112.01 Section III for the product claims 21, 24, 31-32, 40-41.

III. PRODUCT CLAIMS – NONFUNCTIONAL PRINTED MATTER DOES
NOT DISTINGUISH CLAIMED PRODUCT FROM OTHERWISE
IDENTICAL PRIOR ART PRODUCT
Where the only difference between a prior art product and a claimed product is printed

matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. In re Ngai, **>367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004)< (Claim at issue was a kit requiring instructions and a buffer agent. The Federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included instructions and a buffer agent, even though the content of the instructions differed.). See also In re Gulack, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983)("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability ....The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.").

As for claim 10, which deals with the second systems comprises at least one of a customer relationship management (CRM) system, a warehouse management (WM) system, this is fairly taught in HAUSER ET AL, see figures 1-2 (merchant system and central return facility system).

As for claim 11, which deals with the systems comprises the warehouse management (WM) system, this is fairly taught in HAUSER ET AL, see figures 1-2 (central return facility).

As for claim 12, which deals the systems comprises a logistics, execution and shipping (LES) management system; this is fairly taught in HAUSER ET AL {see figures 1-3}.

As for independent claim 13, HAUSER ET AL discloses a method for managing a product return, the method comprising:

1) assigning at least one return authorization number (RAN) to the product return;

{see figures 4-6B, col. 7, lines 63-67, col. 8, lines 1-10 disclose a authorization bar code/RAN is *provided*/sent *to customer* for returning product }

wherein the return request is for a quantity of the product great than one {see col. 4, lines 9-15, discloses a description of the merchandise that identifies items/quantity that should be included for the return request from customer};

2) creating, in a first database of a supplier, a return authorization record for the product return, the return authorization record comprising the RAN;

{see at least figures 4-6B, col. 7, lines 63-67, col. 8, lines 1-10 col. 8, lines 30-60 merchant website or return authorization engine (213) system provide the Return authorization data *include the authorization bar code/or RAN to the customer*}

3) creating, in a second database, a warehouse record for the product return, ware house record comprising a pending delivery item, the pending delivery item including the RAN, a product type, and the quantity of the product associated with the product return;

{see at least col. 4, lines 9-15, discloses the merchant (first system) who has authorized the return of merchandise transmit the return data to the central return service/return online Inc/warehouse (2nd system); and col. 4, lines 49-67; col. 5, lines 1-19 discloses *the return merchandise is received at the return Online Inc, scans the return authorization label applied to the shipping container of merchandise that has been received. Based upon merchant identified by the bar code on the shipping label, the container conveying the merchandise is sorted and transferred to an appropriate processor station. At the processor station, the contents of a shipping container are inspected and the processor verifies that the contents receives in the container match*

the expected contents, based upon data received from the merchant who authorized the

return shipment; and

See also col.6, lines 18-49 discloses National Return Center or Central return

facility 100 or Online Return Inc as a second computer management system wherein

the record or information/data e.g. a *return authorization label including an authorization*

bar code/RAN is stored in the database on computer 56}. As for the information about

the pending delivery item include product type and quantity of the return product, this is

inherently included in HAUSER ET AL since HAUSER discloses the second system

verifies or determines whether the received return product is matched with the return

product record that is received from the first system (merchant).

4) searching the second database using a RAN associated with a product

received at a warehouse;

{see at least see col.6, lines 18-49; col. 6, lines 18-49 discloses verified against

the expected contents/product as indicated in the data stored in the database. And also

col. 4, lines 49-64 discloses the processor verifies that the contents/product received in

the container match the expected contents/product, based up on the data received from

the merchant, the contents product is in association with the authorization code that

identifying the merchant and the merchandise being returned}. This is inherently

determine the searching database for the product return in order to verify or match the

received product with the returned product associated with the authorization code

stored in the database.

5) determining, based on searching the second database, if the quantity of the product associated with the product return included in the warehouse record matches a quantity of the product received at the warehouse;

See col. 4, lines 58-64 discloses *At the processor station, the contents of a shipping container are inspected and the processor verifies that the contents receives in the container match the expected contents, based upon data received from the merchant who authorized the return shipment*; and col. 6, lines 46-49 discloses the contents/product are verifying against the expected product as indicated in the data stored in the database.

7) updating the return authorization and the warehouse record to include information associated with the RAN

{see figure 2, col. 2, lines 27-31; col. 5, lines 5-19 disclose information/data about the product return is entered into the central database of Central return facility to indicate that the merchandise has been received; and if the return product that was received match the expected merchandise, an electronic transmission/message is sent to merchant 14 indicating a complete return of the merchandise occurred}

Note: As for the limitation of" updating a record" in the last step, this is inherently included in the features "*product return is entered into the central database to indicate that the merchandise has been received*, and *send the message to the merchant indicating a complete return of the merchandise occurred* {see figure 2, col. 2, lines 27-31; col. 5, lines 5-19}.

Note as indicated above, the first database in the second step is inherently included in the figure 5-6B "merchant website and return authorization engine" network system.

Furthermore, the claim limitation doesn't exclude a first database and a second database from being different system.   While the claim recites that these databases are from the supplier, the ownership of the system/database doesn't appear to make a manipulative different in a method step of "creating a record in a database'.   Therefore, Hauser discloses "creating a record in the Central return facility comprising a database" which corresponds to the claimed limitation "creating a record in a second computer system of the supplier".

HAUSER ET AL discloses the claimed invention as indicated above. HAUSER ET AL further discloses the quantity or number of items to be returned from the customer, and this information/record is stored in the database system {col. 4, lines 2-23, col. 6, lines 18-49, col. 7, lines 19-37}.   However, HAUSER ET AL doesn't mention the conditions of "splitting/dividing the warehouse record into a plurality of new records including a RAN and having different statuses, when the quantity of the product associated with the product return included in the warehouse record does not match the quantity of the product received at the warehouse".

However, It is noted the splitting/dividing the records is considered as the conditional/optional language based on when the quantity of the product in the record does not match the quantity of the product received at the warehouse, then the splitting record will occur.   In the other words, if all of the quantity/or full of the quantity is

received at the same time, then the splitting/dividing record in to a Plurality of new

records files will not occur or happen.   According to the MPEP, "language that suggests

or makes optional but does not require steps to be performed or does not limit a claim to

a particular structure does not limit the scope of a claim or claim limitation" (MPEP

2106.II. C).

Furthermore, **BLOOM** in par. 0099, figure 9A-9B discloses the well-known

feature of the splitting record of order in to different records or files in order to make

adjustments for an Order Detail record 1202 to partially fill an order, where a select

order an Order Detail record 1202 has a SKU/identifier number quantity greater than

what can be filled. The program (312) creates a new Order Detail Record 1202 and

splitting the Order Detail Quantity across the new record 1202 and the existing record

1202. The program (312) creates a new Order Detail record 1202 by copying all the

values of the existing record 1202, except for quantity.   *Status can be updated to either*

a value such as "retailer shipment-new" or "retailer shipment –back order" on the new

Order Detail record 1202 depending upon the status of the existing record 1202.

Quantity of the existing record can be reduced by the quantity of the new record Status

and Retailer shipment ID (status) on the existing record 1202 are not changed when the

record 1202 is split. (This implies that only the status of existing record 1202 is not

change, which means that the status of new record 1202 can be changed). For

example BLOOM par. 0187, lines 30-79 indicates if the quantity of physical product is

less than the quantity of product in the data records, "*a new Order Detail record 1202*

can be created to split the quantity on the existing record 1202, resulting in the existing

record 1202 retaining its Package ID and Status and having an adjusted Quantity to

match the actual physical quantity that was in the package and the new record 1202

having the same Order ID, a quantity equal to short adjustment quantity, a *Status value*

such as "destination RDC" which indicates the package ID should be repacked.

Therefore, It would have been obvious to one of ordinary skill in the art at the

time of the invention to modify the created record of HAUSER ET AL by splitting the

record order into different record as taught by BLOOM so that the adjusted quantity

product in a new record <u>would match</u> with the actual physical quantity of product that

was received/or received quantity of product and also would be easy to keep track of

what item/product have been received {see Bloom, par. 0187, lines 43-79}.

Also, as for the limitation splitting the second record into a plurality of new

records including the RAN and having different statues, wherein the different statuses

indicate return of a quantity of the product ". Noted that the type of statuses

data/information indicate return of a quantity of the product is considered as

nonfunctional descriptive material because it does not explicitly alter or impact the

step/function of "splitting the record into a plurality of new records" and only means

something to the human mind, thus given little patentable weight.   In the other words,

regardless what type of information contain in the records, the step/function "splitting the

record into a plurality of new records" will not change or impact and the information/data

indicate return of a quantity of the product does not patentably distinguish the claimed

invention form the prior art in terms of patentability. See King Pharmaceuticals Inc. v.

Eon Labs Inc., 95 USPQ2d 1833 (Fed. Cir. 2010).

As for claim **14**, which deals with the return authorization record comprises a plurality of return authorization items, this is fairly taught in HAUSER ET AL {see figures 1-3}.

As for claim **15,** which deals with the return authorization item comprises a unique RAN, this is fairly taught in HAUSER ET AL {see figures 1-3}.

As for claim **16,** which deals with the warehouse record comprises a plurality of pending delivery items, each of the pending delivery items being created for at least one of the return authorization items, this is fairly taught in HAUSER ET AL {see figure 2-3}

As for claim **17,** HAUSER ET AL discloses wherein the second database is a warehouse management (WM) system {see figure 1-2).

As for claim **18,** which deals with information regarding to the return authorization record, e.g. product type and a quantity, this is fairly taught in HAUSER ET AL, see figures 1-3. Furthermore: "the record/information or data of the return authorization" have been determined to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

As for claim 19, which deals with creating a shipping label based on the return authorization record and communicating the shipping label to a customer, this is fairly taught in HAUSER ET AL, {see figures 1-2, col. 4, lines 16-23}.

As for independent claims 20-21, basically these claims carry the similar steps as independent claims 9 and 13 above. Therefore, they are rejected for the same reason sets forth the rejected independent claims 9 and 13 as indicated above.

As for claims 22-23, which deals the first record is a return authorization record and the second record is a pending delivery record this is fairly taught in HAUSER ET AL see figures 2-3, 5-6B.

As for independent claim 24 which is about a computer readable medium containing instructions for carrying a method of managing a return of a product. This claim has the same limitation as independent claim 13 above. Therefore it is rejected as the same independent claim 13 sets forth above.

As for claims 25-26, which deals with the return authorization record comprises a plurality of return authorization items and a return authorization number, this is fairly taught in HAUSER ET AL {see figure 1-3}.

As for claim 27, which deals with delivery item is created for each return authorization item , this is fairly taught in HAUSER ET AL {see figure 1-3}.

As for claim 28, which deals with the second database is a warehouse management database, this is fairly taught in HAUSER ET AL {see figure 1-3}

As for claim 29, which deals with the return authorization record further comprises a product type and a quantity, this is fairly taught in HAUSER ET AL {see figure 1-3}.

Note: As for dep. claims 25-29, "the record/information or data of the return authorization" have been determined to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have otherwise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

As for claim 30, which deals with creating a shipping label based on the return authorization record and communicating the shipping label to a customer, this is fairly taught in HAUSER ET AL {see figure 1-3}

As for independent claim 31 which is about a computer readable medium including a memory containing instructions for carrying a method of managing a return of a product. This claim has the same limitation as independent claim 9 above. Therefore it is rejected as the same independent claim 9 sets forth above.

As for independent claim 32, which discloses a system for managing a return of a product, the system comprising a first computer with a first database, a second computer with a second database {see at least figures 4-5 discloses the merchant computer; and the return center computer} which configured to carry the similar steps

as the steps in independent claim 13. Therefore, it is rejected for the same reason sets forth the rejected independent claim 13 as indicated above.

As for dep. claims 33-35, basically this system claim have the same limitation as the dep. claims 25-27 above, they are rejected for the same reason sets forth the dep. claims 25-27 above.

As for claim 36, which deals with the pending delivery comprises a plurality of pending delivery items each corresponding to a return authorization item, this is fairly taught in HAUSER ET AL, figures 1-3. Note, "the record/information or data of the delivery items" have been determined to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have otherwise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

As for independent claims 40-41, which discloses a system for managing a product return comprises a processor, a memory comprise instructions when executed by the processor cause the system to perform the similar steps of the rejected claims 9 and 13 above. Therefore, they are rejected for the same reason sets forth rejected independent claims 9 and 13 as indicated above.

As for claims 42-44, which deals with the communication between the customer and manufacture for the product return using the website for transmitting the label. This is taught in HAUSER ET AL, see figures 1-2, 5-6B

As for claim 45-47, which deals with the method of communication using the EDI, (electronic data interchange), Basic Application Interface (BAPI) and R/3 information object. This is inherently included HAUSER ET AL {figures 1-3, 5-6B}, wherein the first and second computers communicate using an EDI. Moreover, using these parameters for communicating between two systems is common, old and well known in the art.

(10) Response to Argument

With respect to Appellant's argument in section A (brief 21-24).

Appellant states that the Examiner disregards the claim limitation "when the quality of the product associated with the return request" because of an incorrect reading of MPEP 2106.II.C. However, this is incorrect because the Examiner did not disregard the claim limitation. The Examiner did reconsidered the claim limitation but found it not entitled to weight. In a mean time, the Examiner also applied the reference to teach this limitation as indicated in the rejection above.

Note that by definition, a method claim (process) is a series of act and it requires an action. See In re Nuijten, 84 USPQ2d 1495 "The Supreme Court and this court have consistently interpreted the statutory term "process" to require action". Thus the method claim is necessary direct to the series of act and it is not a hypothetical flow chart or protocol.

Thus, As for the limitation in the methods claims 1, 9, 13, 20, 21, 24, 31 which
recites the conditional language "splitting the second record into a plurality of new
records including the RAN and having different statuses, wherein the different statuses
indicate return of a quantity of the product, when the quantity of the product associated
with the return request included in the second record does not match the quantity of the
product received at the warehouse". In the other words, if all of the quantity/or full of the
quantity is received at the same time, then the splitting/dividing record in to a Plurality of
new records files will not occur or happen. This is similar to the step of "recombining"
the plurality or records into a single record when all the quantity received product
matches with the quantity of product in the second records. In the other words, if the
quantity of product included in the second record doesn't match with the quantity of
product received at the warehouse, then the action of re-combining all the records into
the single record will not happen.

Since Appellant method claim has conditional statement, the action response to
the conditional may never occur. Appellant method claim does not require all the
branches of conditional to perform nor repeating the method step until all the branches
are performed. In other words, the action covers by the claim encompasses performing
the selected conditional to the exclusion of the other alternative. In that regards, the
above claim limitation is an analogous to optional language according to MPEP
2106.II.C since the conditional language need not occur.

With respect to Appellant's argument in section B regarding claims 1, 2, 13, 20, 21, 24, 31-32, 40-41 (brief 26-34).

1) As for the Appellants' argument {brief, pages 26-28, element 1}, Appellant states that "The Examiner's proposed combination of HAUSER and BLOOM fails to disclose at least the claimed "splitting the second record into a plurality of new records.... when the quantity of the product associated with the return request included in the second record does not match the quantity of the product received at the warehouse". Appellant also asserts {brief 27-28} the splitting records in BLOOM is to correct a packing error in delivery. BLOOM discloses splitting records is when a short fall of inventory for delivery, not according to any "quantity of the product received at the ware house" as claimed and thus BLOOM fails to make up the deficiencies of HAUSER at least with respect to the claimed features of claim 1 "splitting the second record...warehouse".

However, Examiner respectfully disagrees with the above argument because:

HAUSER discloses the method and system for managing a return of a product or merchandise wherein the information or record of quantity or number of items to be return are stored in the database system as discussed in the rejection above. Since HAUSER silent regarding to the conditions of "splitting the second records/files into a plurality of new records when the quantity of the product associated with the return request included in the second record does not match the quantity of the product received at the warehouse", the Examiner is used the fair teaching of BLOOM to show

the splitting record when the physical quantity of the items are received are less than the quantity of the items stored in the record.

For example BLOOM par. 0099 discloses the new order detail record 1202 and the existing detail record 1202. Specifically {figure 9A-9B par. 0099 (lines 1-35)} discloses *the program (312) can make adjustments to an Order Detail record 1202 to partially fill an order, where a selected Order Detail record 1202 has a SKU quantity greater than what can be filled by the cases, which have been included in the retailer shipment*, and {par.0099 (lines 16-35} discloses *the program can attempt to partially fill the order by creating a new Order Detail record 1202 and splitting the Order Detail Quantity across the new record 1202 and the existing record 1202. The program (312) creates a new Order Detail record 1202 by copying all the values of the existing record 1202, except for quantity. Status can be updated to either a value such as "retailer shipment-new" or "retailer shipment –back order" on the new Order Detail record 1202 depending upon the status of the existing record 1202. Quantity of the existing record can be reduced by the quantity of the new record Status and Retailer shipment ID (status) on the existing record 1202 are not changed when the record 1202 is split.*

BLOOM further discloses in par. 0187, lines 47-79 indicates if the quantity of physical product is less than the quantity of product in the data records "*a new Order Detail record 1202 can be created to split the quantity on the existing record 1202, resulting in the existing record 1202 retaining its Package ID and Status and having an adjusted Quantity to match the actual physical quantity that was in the package and*

the new record 1202 having the same Order ID, a quantity equal to short adjustment

quantity, a Status value such as "destination RDC" , and no Package Id value.

Noted that the Appellant mainly focuses on the prefer embodiment of BLOOM

that the splitting records in BLOOM is used for correcting a packing error in a delivery

{brief 27-28, but not the fair teachings of "splinting the record" as shown in BLOOM. As

indicated above, BLOOM is used to show the fair teaching of "splitting record 1202 or

creating the new record 1202 when the physical quantity of the items are received are

less than the quantity of the items stored in the record so that the new record would

match with the actual physical quantity.

Therefore, It would have been obvious to one of ordinary skill in the art at the

time of the invention to modify the created record of HAUSER ET AL by splitting the

record order into different record as taught by BLOOM so that the adjusted quantity

product in a new record <u>would match with the actual physical quantity</u> of product that

was received/or received quantity of product and also would be easy to keep track of

what item/product have been received {see Bloom, par. 0187, lines 43-79}. For the

reason as indicated above, the Office Action has provided a motivation to one of

ordinary skill in the art to modifying the teachings of the prior art to achieved the claimed

limitation

As a result, the combination of HAUSER and BLOOM teach "splitting the second

record into a plurality of new records…. when the quantity of the product associated

with the return request included in the second record does not match the quantity of the

product received at the warehouse" as recited in claims 1, 2, 13, 20, 21, 24, 31-32, 40-41.

2) As for the Appellants' argument {brief, pages 28-29, element 2}, Appellant states that "the Examiner admits that the combination of HAUSER and BLOOM fails to disclose at least one claimed feature and provides only a conclusory statement that this feature (the recombining the records into a single record) is obvious {brief 28}, The Examiner's rejection fails to assert that the "recombining all the records into a single record" is a known technique. However, the Examiner respectfully disagrees with this argument because HAUSER/BLOOM discloses the splitting the record into another records when the problem occur such as when the quantity of received product does not match with the original quantity of product stored in the record as stated as above. Therefore, it would have been obvious to one of ordinary skill and creativity in the art would have readily recognized to recombine the all the records into a single record when the problem has been solved (e.g. when the quantity of received product matches with the original quantity of product stored in the record) as a matter of common sense of indicating the problem has been solved as well as saving the space in the data storage. Since the split was only formed because of the problem, one of ordinary skill and creativity in the art would have readily recognized no more need for split and would not need to maintain the overhead of duplicate records.

3) As for the Appellants' argument {brief, pages 31-33, element 3}, Appellant states that "the Examiner's combination of HAUSER and BLOOM fails to teach the claimed feature of recombining the records, would at least change the principle of

operation of BLOOM and render BLOOM unsatisfactory for its intended purpose".

However, the Examiner respectfully disagrees with this argument due to the reason the

Examiner addressed in section (2) above.}

     4) As for the Appellant's argument {brief, pages 33-34, element 4}, Appellant

states that the Examiner has chosen not to considered claim words "of a supplier" in

independents claims 13, 20, 21, 24, 31, 32 and 41. However, the Examiner is

respectfully disagrees with this argument.

     As for the features "creating at least one record in each of a plurality of a second

computer implemented management system (second database) of <u>a supplier</u>…" as

recited in the method claims 9, 13, 20, 21, 24, 31 and "a second computer comprising a

second database of the supplier" as recited in the system claims 32 and 41, HAUSER

discloses the second computer implement management system which is perform the

function of creating a second records as shown in the rejection above {see claim 1 (step

5) and claim 13 (step 3)}. While the claim recites that second computer implement

management system is the system of a supplier, the Examiner asserts that the

ownership of the system <u>doesn't appear</u> to make a manipulative different in a method

step of <u>"creating</u> a record' as indicated in the method, and "the supplier" as recited in the

system claims 32 and 34 is merely the ownership name of the database which also

does not change the structure of the computer as well as the function of "create the

record". Therefore, HAUSER discloses "creating a record in the Central return facility

comprising a database corresponds to the claimed limitation "creating a record in a

second computer system of the supplier (See the details in the rejection of claim 1 step

(5) and claim 13 step (3) above).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejection should be sustained.

Respectfully submitted,

/K. N./

Examiner, Art Unit 3689

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